

REMARKS

Claims 1-23 are pending in the present application. No amendments were made to the claims. Reconsideration of the claims is respectfully requested. Also, applicant's representative thanks the examiner for the interview on Wednesday, November 5, 2003. The examiner said that she would review applicants' interpretation of *McDowell* in more detail. Specifically, column 14 lines 37-60 of this reference teaches inserting data into a database or table, rather than into an email message.

I. 35 U.S.C. § 103, Obviousness, Claims 1, 2, 4, 10-13, 15, and 21-23

The examiner has rejected claims 1, 2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over *McDowell et al.*, United States Patent Number 6,438,583 ("*McDowell*"). This rejection is respectfully traversed.

In rejecting the claims, the examiner stated the following:

In considering claims 1, 4, 11-12, 15, and 22, *McDowell* discloses a system and method for re-routing electronic mail messages, the method comprising:

determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient (*Col 8, lines 32-37, McDowell discloses the re-route server, after receiving e-mail; determines if the recipient of the e-mail is a re-route customer, wherein if the recipient is determined to be a re-route customer then it is determined that the e-mail for the recipient is to be forwarded to the recipient's "toAccount" address or another address provided by the recipient*);

while *McDowell* discloses the re-route server's mail software performing additional operations such as: interfacing to the re-route subscriber database to insert information about current events (e-mail status, sender, date, etc.)(*Col. 14, lines 37-46*), *McDowell* does not explicitly disclose wherein the e-mail status information inserted by the re-route server includes an indicator identifying the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient.

Nonetheless, Examiner takes official notice that including an indicator in an electronic mail message identifying the mail message as being forwarded is well known in the art. Accordingly it would have been obvious to a person having ordinary skill to modify the inserted information (the e-mail status information or the indicator) to include information identifying the e-mail as being forwarded from an old address

in order inform the user that the e-mail was sent from a known user or source, thereby ensuring more security in the case of spam mail, junk e-mail, or viruses. Therefore, the aforementioned limitation would have been an obvious modification to the system as disclosed by *McDowell*.

Office Action dated 9/12/2003, pages 2-3.

A. The examiner bears the burden of establishing a *prima facie* case of obviousness.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this particular case, the examiner has failed to establish a *prima facie* case of obviousness based on the prior art. More specifically, the cited reference cannot be interpreted in the manner stated by the examiner in the office action. Further, the official notice taken by the examiner cannot be combined with the cited reference in the manner stated by the examiner.

B. All claim limitations must be considered, especially when missing from prior art.

In comparing *McDowell* to the claimed invention, the features of the presently claimed invention may not be ignored in an obviousness determination. Claim 1 reads as follows:

1. A method in a data processing system for processing an electronic mail message, the method comprising:
determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient; and
including an indicator identifying the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient.

Independent claims 11, 12, and 22 include similar features. The indicator in these claims is placed into the electronic mail message, which is also referred to as an email message.

In contrast, the information in *McDowell* is not placed into the electronic mail message, but into a database. For example, the portion of *McDowell* cited by the examiner is included in the following section:

In addition to typical e-mail processing, the re-route server's mail software performs additional, optional operations. These additional operations include:

interfacing to the re-route subscriber database/tables to query information on subscriber preferences (status, spam filtering, sender notification, virus checking, etc.)

interfacing to the re-route subscriber database/tables to insert information about current events (e-mail status, sender, date, etc.). This information will be used for billing and report generation.

McDowell column 14 lines 37-47.

As can be seen, this portion of the cited reference does not teach inserting email status information into an electronic email message. Instead, *McDowell* teaches interfacing to a database or to tables to insert this type of information into a database or tables. This portion of *McDowell* specifically states that the interfacing step is made to a database or tables. Further, this portion of *McDowell* teaches that the interfacing is to insert information about current events. Nowhere does *McDowell* state that the insertion of information is into an email message. Instead, the description of the operation is with respect to subscription database/tables. This interpretation is further supported by the fact that this information is used for billing and report generation. Placing this information into a database, rather than into an email message, makes sense if the information is to be used for billing and report generation.

C. Stating that it is obvious to try or make a modification or combination without a suggestion in the prior art is not *prima facie* obviousness.

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

No teaching, suggestion, or incentive is present in *McDowell* for including an indicator regarding email status information within the electronic email message itself.

Further, the examiner has provided no teaching, suggestion, or incentive based on the prior art for using an indicator that identifies the electronic mail message as being forwarded from an old address when the electronic mail message is forwarded to another address associated with the recipient.

The examiner has provided a reason as to why the indicator of the present invention would be desirable, but, however, has not pointed out where such a suggestion or incentive can be found in the prior art. Specifically, the examiner has pointed out no teaching, incentive, or suggestion based on the prior art for using this indicator for informing a user that the electronic mail message was sent from a known user or source, thereby ensuring more security in the case of spam mail, junk email, or viruses. This reason is one developed by the examiner, rather than being based on the prior art. As a result, this modification or combination cannot be made because the examiner has not pointed out where in the prior art this suggestion or motivation can be found. The current rationale is an improper one provided by the examiner. Therefore, the combination and suggestion cannot be made.

D. When properly interpreted, combination proposed by the examiner does not reach the presently claimed invention.

When properly interpreted, *McDowell* storing status information regarding electronic mail messages in a database or in tables. Nowhere does *McDowell* teach inserting email status email information into an electronic mail message. The official notice taken by the examiner is that an indicator may be included in an electronic mail message to indicate that the electronic mail message has been forwarded. Nowhere has the examiner pointed out any teaching, suggestion, or incentive based on the prior art for modifying this type of indicator to indicate that the electronic mail message has been forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient.

Therefore, a combination of these two teachings would result in email status information being placed into a database or into tables with the forwarded indicator being included in the database or tables and/or in the electronic mail message. In contrast, the presently claimed invention determines if the electronic mail message is to be forwarded to another address associated with the recipient. The indicator of the present invention

identifies the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient. Thus, the combination of *McDowell* and the official notice taken by the examiner would not reach the presently claimed invention.

E. The proposed modification of *McDowell* would not be made when *McDowell* is considered as a whole.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). In the present case, one of ordinary skill in the art would not modify placing email status information into a database or tables to inserting an indicator identifying the electronic mail message as being forwarded from an old address into the electronic mail message in which the electronic mail message is being forwarded to the recipient when *McDowell* is considered as a whole.

McDowell is directed to the following problem:

One of the most basic services offered by Internet Service Providers (or "ISPs") is a private or corporate e-mail account that a customer may use for transmitting and receiving electronic mail (e-mail) messages via the Internet. Each of these e-mail accounts has a unique address.

Internet service customers are notoriously fickle in their choice of ISPs. The customer turnover rate is typically 50% each year for most ISPs (those ISPs that do not have meaningful market competition have lower turnover, of course). When a customer closes an account at one ISP and opens a new account at another ISP, the customer cannot maintain the same e-mail address. This is a natural result of the currently used e-mail addressing convention wherein part of the address includes an identification of the ISP. Thus, when the ISP changes, at least a part of the e-mail address must also change.

This is inconvenient because e-mail gets lost. In the prior art, e-mail messages sent to a defunct address (belonging to an inactive account) are either acknowledged as being undeliverable or they are simply ignored. Colloquially, acknowledgement by an ISP that the message is undeliverable as addressed is known as "bouncing" the message back to the sender. Although this doesn't get the message to the intended recipient and it fails to inform the sender of a correct address (if any exists) for the

intended recipient, at least it puts the sender on notice that they have attempted to use an inaccurate e-mail address.

Simply ignoring an undeliverable message, as is done by some ISPs, is quite non-helpful because the sender remains ignorant that the message was sent to an inaccurate address.

McDowell, column 1, lines 13-42.

As can be seen, *McDowell* is directed towards a problem associated with electronic mail messages being "bounced" back to the sender.

In contrast, the presently claimed invention is directed towards a different problem from that in *McDowell*. Specifically, the presently claimed invention recognizes the following problem:

The Internet also provides a medium for sending electronic mail messages between different users or recipients. These electronic mail messages are also referred to as email. With email, a user may send a message to one or more recipients almost instantaneously. Some users may have more than one email address. Additionally, email addresses are constantly changing for different reasons. Sometimes, a user may change service providers and receive a new email address. Other times, a service provider may be bought by or merged with another service provider. Sometimes when a service provider is bought or merged with another service provider, the combined entity will force or require some users to change domain names to have a consistent domain name in the email addresses.

When such a situation occurs, a user changing email addresses is required to notify everyone of the email address change. In many cases, when a change in domain name is required by a service provider, a grace period may be present in which both email addresses are accepted. When a user changes service providers, the user typically will maintain the old email address for a period of time and have the email sent to the old address forwarded to the new address.

It is important for a user to recognize that email is being forwarded from the original address to the new address in order to notify the sender of the email of the address change. Currently, this forwarding must be detected by looking at the "to:" field in the message to determine whether the address is the old address. In some cases, the message may be sent to many recipients in which all of these recipients are listed in the "to:" field. Such a procedure can become tedious when many recipients are listed for the email. Further, even if the user is meticulous in checking every email received to see whether it was forwarded from an old address, the address may not appear at all. For example, some email may be sent via distribution lists using a remailer program. In this case, the sender sends a note addressed to the distribution list on the server and the program distributes

the email to all addresses currently found on the list. The "to:" field in the note may show for example, "distlistmail@abcd.org" rather than all of the addresses in the list. The actual address in this case is located in the routing information, but this information is typically removed by many email programs.

Specification, page 2, line 8-page 3, line 21.

In other words, the problem recognized by the present invention is a problem associated with a user receiving electronic mail messages from an old address for the user in which this electronic mail message is forwarded to a new address for the user, rather than problems associated with an electronic mail message being directed towards an invalid address. Therefore, the problem is recognized by *McDowell* and the presently claimed invention are vastly different.

Further, the solution from *McDowell* is described as follows:

The present invention is a method and apparatus for the rerouting of e-mail from a prior or non-working address to the new address of a recipient. In general, two basic re-route methods are employed, varying as noted more fully below. E-mail that is to be sent to a recipient is sent to the former Internet Service Provider (ISP). Since the recipient is no longer a subscriber to the old ISP, the e-mail is re-routed to a re-route server of the present invention. The re-route server then causes the e-mail to be sent to the correct address through a variety of means. This embodiment provides privacy with respect to the new address of the recipient since it is known only to the re-route server and NOT to the old ISP.

Alternatively, new e-mail addresses are made available at the old ISP. The old ISP can then forward e-mail directly to the new ISP. This has the advantage of a direct route from the old ISP to the new ISP. However, privacy of the new e-mail address for the recipient is less since the address is now known to the old ISP.

McDowell, column 1, lines 46-64.

As can be seen, *McDowell* teaches trying to route an electronic mail message from a nonworking address to a new address for the recipient. In contrast, the presently claimed invention includes an indicator to identify the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded from another address associated with the recipient.

In other words, *McDowell* provides a method and apparatus for attempting to reroute an electronic mail message to a valid address, while the presently claimed

invention includes a indicator that the electronic mail message has been forwarded from an old address for the recipient. Thus, one of ordinary skill in the art would not be motivated to make the necessary changes to *McDowell* to reach the presently claimed invention when this reference is viewed as a whole.

F. The presently claimed invention may be reached only though an improper use of the disclosed invention as a template to piece together and modify the prior art.

Moreover, the examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, *McDowell* and the official notice taken by the examiner cannot be properly combined and modified to form the presently claimed invention. In this case, no teaching, suggestion, or incentive is present for combining the storing of email status information in a database or in tables with an indicator identifying an electronic mail message as being forwarded, and then, modifying the indicator to identify the electronic mail message as one being forwarded from an old address in response to the mail message being forwarded to another address associated with the recipient.

As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through the impermissible use of hindsight with the benefit of applicant's disclosure a model for the needed changes.

Therefore, the rejection of claims 1, 2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 has been overcome.

II. 35 U.S.C. § 103, Obviousness, Claims 3, 5-9, 14, and 16-20

The examiner has rejected claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over *McDowell et al.*, United States Patent Number 6,438,583 ("*McDowell*") in view of Berkowitz, United States Patent Number 6,088,720 ("*Berkowitz*"). This rejection is respectfully traversed.

These claims are patentable over the cited references for the same reasons as the independent claims discussed above because these claims are dependent claims, depending from one of the independent claims. As a result, a combination of Berkowitz with *McDowell* also would not reach the presently claimed invention because the independent claims are patentable in view of *McDowell*.

Therefore, the rejection of claims 1, 2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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